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10/578,319

02/05/2007

Xaver Wirth

566/44949

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23646 7590 12/03/2010
BARNES & THORNBURG LLP
750-17TH STREET NW
SUITE 900
WASHINGTON, DC 20006-4675

EXAMINER

NGUYEN, XUAN LAN T

ART UNIT

PAPER NUMBER

3657

NOTIFICATION DATE

DELIVERY MODE

12/03/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

vrobertson@btlaw.com
DocketingPAT-DC@btlaw.com

| | | | |
|------------------------------|--------------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/578,319 | Applicant(s) WIRTH ET AL. | |
| | Examiner Lan Nguyen | Art Unit 3657 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/14/10</u> . | 6) <input checked="" type="checkbox"/> Other: <u>approved spec.</u> |

DETAILED ACTION

Specification

1. The amendment to the specification filed on 9/27/10 has been approved and entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- The singularity and plurality of the claimed features: sliding elements, grooves, bolt, through hole, insertion hole, etc. as recited in the claims are very confusing. It is unclear the exact structure of the disk that is being claimed. Applicant is urged to review the claims and to clarify the plurality/singularity and the corresponding plurality/singularity of the grooves, the sliding elements, the through holes and the bolts.
- It is noted that Applicant did not correct the deficiencies in the antecedent basis for the claimed features: through holes, grooves, sliding elements, etc. in the dependent claims. Applicant is again urged to review the claims and provide proper antecedent basis for these claimed features.

Art Unit: 3657

- Due to the above noted deficiencies, claims 1-19 are being treated as best understood.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Eaton et al. (3,295,641).

Re: claim 1, Eaton shows a brake disk for a rail vehicle, as in the present invention, the brake disk comprising: a hub 2, at least one friction ring 4 having a radial groove 5 and fastened by a clamping bolt 11 to the hub, a sliding element 6 having a shank and being connected to the hub, the sliding element engaging in the radial groove for anti-rotation locking and centering of the at least one friction ring; and the sliding element extending parallel to an axis of the clamping bolt, as shown in figure 1.

Re: claims 2 and 15, Easton shows the groove extending in towards or out away from the center of the hub as claimed, in figures 1 and 3.

Re: claims 3, 4, 6, 14 and 16, Eaton shows a though hole, not numbered, in the hub where pin 6 is located; said sliding element is a guide pin with a head in said groove as claimed and said sliding element is a straight pin.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5, 7-13 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eaton et al. (3,295,641).

Re: claims 5, 7, 17 and 18, the claimed features in claims 5, 7, 17 and 18 are considered to be engineering design choices to fit a certain size and/or shape as required in order to meet certain requirements of strength and performance and would have been obvious to one of ordinary skill in the art at the time of the invention to have selected a certain size and/or shape as a routine in the engineering design process.

Re: claims 8 and 9, the different shapes of the sliding element are considered to be obvious variants of the sliding elements and would have been obvious for one of ordinary skills in the art to have selected one of these shaped sliding elements to be used in the disk of Eaton and still achieves the same result of anti-rotation locking and centering of the disk.

Re: claims 10-13, Eaton's disk, as rejected above, shows the sliding element being arranged in a circumference of the hub but lacks the number of sliding elements. The numbers of the sliding elements are considered to be engineering design choices in order to meet certain requirements of strength and performance while provide adequate

Art Unit: 3657

thermal expansion and would have been obvious to one of ordinary skill in the art at the time of the invention to have selected a certain number of sliding elements as a routine in the engineering design process.

Re: claim 19, Eaton does not show the material of the sliding element. The Examiner takes an official notice that steel is a well known and a standard material for use in pins, bolts, screws, etc. for its strength and durability.

Response to Arguments

8. Applicant's arguments, filed 9/27/10, with respect to the rejection(s) of the claim(s) under Lehmann et al. have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Eaton et al. as presented above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Nguyen whose telephone number is (571) 272-7121. The examiner can normally be reached on Monday through Friday, 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Siconolfi can be reached on (571) 272-7124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3657

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Xuan Lan Nguyen/
Primary Examiner
Art Unit 3657